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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,181	05/29/2001	Dana Howard Jones	513612000100	6792
25224	7590	06/04/2004	EXAMINER	
MORRISON & FOERSTER, LLP 555 WEST FIFTH STREET SUITE 3500 LOS ANGELES, CA 90013-1024			POND, ROBERT M	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 06/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/867,181	JONES, DANA HOWARD
	Examiner	Art Unit
	Robert M. Pond	3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 29 May 2001.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-39 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-39 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 29 May 2001 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/28/01</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1-3, 6, 7, 10-32, 34, 37, and 38 are rejected under 35 USC 102(b) as being anticipated by Goldhaber et al. (patent number 5,794,210, hereinafter referred to as "Goldhaber").**

Goldhaber teaches all the limitations of Claims 1-3, 6, 7, 10-32, 34, 37, and 38. For example, Goldhaber discloses a method of advertisers gaining the attention of consumers accessing the Internet via attention brokerage and compensating consumers who pay attention to the advertisement (please see at least title, abstract; col. 4, lines 34-35; col. 9, lines 34-36). Goldhaber discloses advertisers as sponsors embedding advertisements with content most likely to reach the advertiser's target audience referred to as linking sponsorship (see at least col. 2, lines 24-27). Goldhaber discloses

decoupling advertising from the content referred to as orthogonal sponsorship (see at least col. 5, lines 46-47). Goldhaber further discloses:

- *Providing a product at a networking site; product covered by intellectual property:* (see at least abstract; Fig. 1 (102); col. 1, lines 4-8; col. 3, lines 51-55; col. 5, lines 11-13; col. 6, lines 3-7; col. 9, lines 32-41).
- *Restricting access to product:* restricts access to valuable information until information provider receives compensation (e.g. television program, prerecorded music, magazine or newspaper article, research report)
- *Facilitating the display of a sponsor message to a consumer:* (see at least abstract; col. 9, lines 62-67).
- *Allowing access to a product after facilitating display; purchasing product:* seeing an ad and requesting the film clip; making a purchase (see at least Fig. 13 (314); col. 5, lines 11-13; col. 18, lines 53-55).
- *Maintaining a consumer activity log:* creates consumer profile; maintains profile, updates profile (see at least col. 13, line 33 through col. 14, lines 56).
- *Authoring sponsor message:* advertiser creates ad at site (see at least Fig. 8 (68, 106); col. 14, lines 17-20).
- *Consumer sign-up:* providing personal data, contact data, profile data, taking acceptance action, password (see at least col. 12, line 45 through col. 13, line 40).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 4, 5, 8, 35, and 36 are rejected under 35 USC 103(a) as being unpatentable over Goldhaber (patent number 5,794,210), in view Wiser et al. (patent number 6,385,596 hereinafter referred to as “Wiser”).

Goldhaber teaches all the above as noted under the 102(b) rejection and teaches a) advertising intellectual property products, b) compensating information providers for purchased content (e.g. prerecorded music, television programs, search reports), and c) trading houses providing automatic royalty tracking (see at least col. 19, line 19 through col. 20, line 53; col. 20, lines 54-55), but does not disclose making royalty payments.

Wiser teaches protecting a content owner's intellectually property rights over a network, and further teaches tracking and making royalty payments to a content owners and facilitators (see at least col. 9, lines 39-53; col. 11, lines 49-61). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Goldhaber to disclose making royalty payments as taught by Wiser, in order to disclose the purpose of royalty tracking, and thereby attract content owners and facilitators to the service desiring to be paid royalties.

Goldhaber teaches all the above as noted under the 103(a) rejection, but does not disclose entering into a license agreement with the owner of the intellectual property. Wiser teaches all the above as noted under the 103(a) rejection and further teaches

consumers and facilitators entering into a license agreement with the owner of intellectual property (see at least abstract; Fig. 1A (108, 116); Fig. 1B (110); col. 1, lines 45-47; col. 5, lines 56; col. 10, lines 18-48). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Goldhaber to implement licensing as taught by Wiser, in order to protect the intellectual property rights of the product owner.

4. Claims 9 and 39 are rejected under 35 USC 103(a) as being unpatentable over Goldhaber (patent number 5,794,210).

Goldhaber teaches all the above as noted under the 102(b) rejection and further teaches inactivating a CyberCoin to prevent a consumer from receiving additional compensation by merely accessing the same advertisement (see at least col. 17, lines 49-52), but does not disclose barring the owner of intellectual property from pretending to be a consumer. It would have been obvious to one of ordinary skill in the art at time of the invention to disclose barring the content provider from pretending to be a consumer, since it is well within the skill to ascertain that content providers are capable of abusing the system as well as consumers.

5. Claims 33 are rejected under 35 USC 103(a) as being unpatentable over Goldhaber (patent number 5,794,210).

Goldhaber teaches all the above as noted under the 102(b) rejection and teaches advertisers directly compensating a consumer via payment for viewing and paying attention to an advertisement, and further teaches a consumer using the payment to compensate the information provider via another payment for providing entertainment or

other information the consumer wishes to access (see at least col. 12, lines 5-11).

Goldhaber, however, does not teach the consumer viewing a sponsor message as an alternative to direct payment for the selected product. It would have been obvious to one of ordinary skill in the art at time of the invention to disclose the consumer viewing a sponsor message as an alternative, since it is well within the skill to ascertain the sponsor could have paid the entertainment content provider directly for the content the consumer desired.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Ebenkamp, Becky; "Gold on that thar Web," Brandweek, 15 July 1996, v37n29pg17, 3pgs, Proquest #9892249; teaches CyberGold's attention brokerage system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mr. Robert M. Pond** whose telephone number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:30AM-5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Mr. Vincent Millin** can be reached on 703-308-1065.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

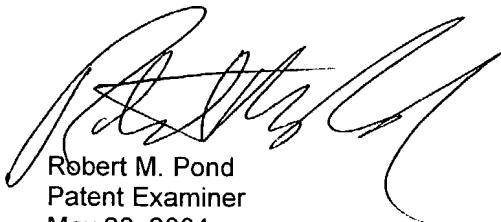
or faxed to:

703-872-9306 (Official communications; including After Final communications labeled "Box AF")

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Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,
Arlington, VA, 7th floor receptionist.



A handwritten signature in black ink, appearing to read "Robert M. Pond".

Robert M. Pond
Patent Examiner
May 28, 2004